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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Lei Yu

Serial No.: 09/626,616

Filed: July 27, 2000

For: POLYNUCLEOTIDE ENCODING MU
OPIOID RECEPTOR

Group Art Unit: 1647

Examiner: R. Landsman

Atty. Dkt. No.: INDA:005USD1

CERTIFICATE OF FACSIMILE TRANSMISSION 37 C.F.R. § 1.8	
I certify that this correspondence is being transmitted to: Office of Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, facsimile number (703) 308-6916 on the date below:	
October 24, 2006 Date	 Mark B. Wilson

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(d)

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicants request a reconsideration of patent term adjustment under 37 C.F.R. §1.705(d). The Determination of Patent Term Adjustment under 35 U.S.C. 154(b) included with the Notice of Allowance indicates a Patent Term Adjustment of 341 days, and the issued patent, U.S. 7,097,988, indicates a Patent Term Adjustment of 677 days. U.S. patent 7,097,988 is not subject to a terminal disclaimer. Attached is a copy of the Patent Application Information Retrieval (PAIR) system's calculations of Patent Term Adjustment.

On 6 October 2005, the USPTO received an issue fee transmittal form and a Response to the Examiner's Amendment in the Notice of Allowance. A copy of this Response and the return postcard from the USPTO are attached.

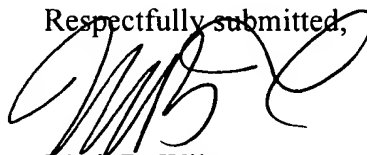
As indicated on the attached copy of the PAIR system's calculations of Patent Term Adjustment, the Response is listed as a "Miscellaneous Incoming Letter", received on 6 October 2005, and an applicant delay of 120 days is shown. The Response, which provides comments regarding the reasons for allowance, should not be listed as an Applicant delay of 120 days. As stated in MPEP§2732, submitting a response to Examiner's reasons for allowance is not a delay by the Applicant. Accordingly, Applicants request that the Patent Term Adjustment should be adjusted by $677+120=797$ days.

The undersigned would also like to thank Kerry Fries at the USPTO for his helpful conversation on 12 October 2006. It is believed that the Response of 6 October 2005 should not have been entered as a "Miscellaneous Incoming Letter" in PAIR.

Applicants respectfully request an adjustment of the patent term from 677 days to 797 days, a collective patent term adjustment of 120 days in light of the above mentioned issues.

Because the error in patent term adjustment was due to the USPTO, Applicants request that the fee be waived. However, if a fee is due (*e.g.*, in accordance with 37 C.F.R. § 1.18(e)), then the Commissioner is hereby authorized to deduct the necessary fee from Fulbright & Jaworski Deposit Account No.: 50-1212/INDA:005USD1.

Respectfully submitted,

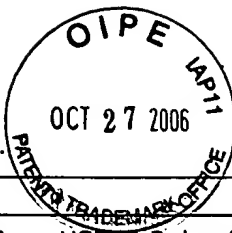


Mark B. Wilson
Attorney for Applicant

FULBRIGHT & JAWORSKI, L.L.P.
600 Congress Ave., Ste. 1900
Austin, Texas 78701
(512) 474-5201

Date: October 24, 2006

Search results as of: 10-13-2006::14:51:21 E.T.

**Patent Term Adjustment**

Filing or 371(c) Date:	07-27-2000	USPTO Delay (PTO) Delay (days):	1129
Issue Date of Patent:	08-29-2006	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	452
Post-Issue Petitions (days):	+0	Total Patent Term Adjustment (days):	677
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
08-09-2006	PTA 36 Months	257	
08-29-2006	Patent Issue Date Used in PTA Calculation	204	
02-07-2006	Receipt into Pubs	↑	
11-28-2005	Dispatch to FDC	↑	
11-07-2005	Sequence Forwarded to Pubs on Tape	↑	
10-06-2005	Miscellaneous Incoming Letter		120
10-14-2005	Application Is Considered Ready for Issue		↑
10-06-2005	Issue Fee Payment Verified		5
10-06-2005	Issue Fee Payment Received		↑
07-12-2005	Receipt into Pubs		↑
07-01-2005	Mail Notice of Allowance		↑
06-29-2005	Notice of Allowance Data Verification Completed		
06-29-2005	Case Docketed to Examiner in GAU		
04-01-2005	Mail BPAI Decision on Appeal - Reversed	668	
03-31-2005	BPAI Decision - Examiner Reversed	↑	
02-23-2005	Docketing Notice Mailed to Appellant	↑	
02-22-2005	Assignment of Appeal Number	↑	
02-08-2005	Appeal Awaiting BPAI Docketing	↑	
12-22-2004	Appeal Awaiting BPAI Docketing	↑	
11-23-2004	Mail Miscellaneous Communication to Applicant	↑	
11-23-2004	Miscellaneous Communication to Applicant - No Action Count	↑	
01-27-2004	Reference capture on IDS	↑	
01-27-2004	Information Disclosure Statement (IDS) Filed	↑	
01-14-2004	Mail Examiner's Answer	↑	
01-12-2004	Examiner's Answer to Appeal Brief	↑	
11-19-2003	Date Forwarded to Examiner	↑	
11-07-2003	Appeal Brief Filed	↑	
11-07-2003	Request for Extension of Time - Granted	↑	
11-07-2003	Request for Extension of Time - Granted	↑	
06-04-2003	Notice of Appeal Filed		65
06-04-2003	Request for Extension of Time - Granted		↑
12-31-2002	Mail Final Rejection (PTOL - 326)		↑

12-30-2002	Final Rejection	
10-15-2002	Date Forwarded to Examiner	
09-30-2002	Response after Non-Final Action	31
09-30-2002	Request for Extension of Time - Granted	↑
05-30-2002	Mail Non-Final Rejection	↑
05-30-2002	Non-Final Rejection	
04-15-2002	Date Forwarded to Examiner	
04-11-2002	Supplemental Response	44
03-11-2002	Date Forwarded to Examiner	↑
02-26-2002	Response after Non-Final Action	132
02-26-2002	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received	↑
07-17-2001	Mail Non-Final Rejection	↑
07-16-2001	Non-Final Rejection	
04-30-2001	Information Disclosure Statement (IDS) Filed	19
05-09-2001	Date Forwarded to Examiner	↑
04-30-2001	Supplemental Response	↑
04-24-2001	Date Forwarded to Examiner	↑
04-11-2001	Response after Non-Final Action	36
04-11-2001	Request for Extension of Time - Granted	↑
12-06-2000	Mail Non-Final Rejection	↑
12-04-2000	Non-Final Rejection	
12-04-2000	Case Docketed to Examiner in GAU	
11-30-2000	CRF Is Good Technically / Entered into Database	
07-27-2000	Preliminary Amendment	
09-12-2000	Application Dispatched from OIPE	
09-12-2000	Correspondence Address Change	
08-16-2000	IFW Scan & PACR Auto Security Review	
07-27-2000	Initial Exam Team nn	

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PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: Mail

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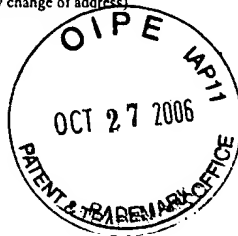
INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

7590

07/01/2005

Mark B Wilson
 Fulbright & Jaworski L L P
 600 Congress Avenue
 Suite 2400
 Austin, TX 78701



Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (703) 746-4000, on the date indicated below.

Gina N. Shishima (Depositor's name)
 (Signature)
 October 3, 2005 (Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,616	07/27/2000	Lei Yu	INDA:005USD1	1049

TITLE OF INVENTION: METHODS OF SCREENING FOR SUBSTANCES THAT BIND OPIOID RECEPTORS

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	YES	\$700	\$0	\$700	10/03/2005

EXAMINER	ART UNIT	CLASS-SUBCLASS
LANDSMAN, ROBERT S	1647	435-007100

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.

☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.

2. For printing on the patent front page, list

(1) the names of up to 3 registered patent attorneys or agents OR, alternatively,

(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1 _____
 2 Fulbright & Jaworski LLP
 3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please indicate receipt of the below-identified paper:

☐ New Application For: _____ Priority Date: _____

☐ Foreign priority already claimed: _____

☐ Continuation ☐ CIP _____

☐ Specification: _____ Pages _____ ☐ Divisional CPA ☐

☐ Response to Office Action Dated: _____ ☐ Drawings: _____ Sheets _____

☒ Other: Issue Fee Payment Transmittal, Response to Examiner's Amendment; \$700.00 check, Postcard ☐ Final Rejection

☐ Assignment Enclosed ☒ Cert. of Timely Mailing ☐ Exp. Mail: _____

IDENTIFICATION OF APPLICATION

Serial No.: 09/626,616

Title: METHODS OF SCREENING FOR SUBSTANCES WHICH BIND OPIOID RECEPTORS

Applicant: Lei Yu

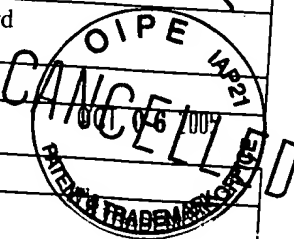
Client: Indiana University

Mailed: October 3, 2005 Filed: _____

Attorney: MBW/GNS

F&J File No.: INDA:005USD1

Due Date: October 3, 2005



PART B - FEE(S) TRANSMITTAL

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 Alexandria, Virginia 22313-1450
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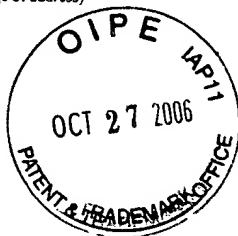
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 (Signature)
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1 _____
 2 Fulbright & Jaworski LLP
 3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Advanced Research and Technology Institute

Indianapolis, IN

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☒ Corporation or other private group entity ☐ Government

4a. The following fee(s) are enclosed:

- ☒ Issue Fee
☐ Publication Fee (No small entity discount permitted)
☐ Advance Order - # of Copies _____

4b. Payment of Fee(s):

- ☒ A check in the amount of the fee(s) is enclosed.
☐ Payment by credit card. Form PTO-2038 is attached.
☒ The Director is hereby authorized by charge the required fee(s), or credit any overpayment, to Deposit Account Number _____ (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

- ☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27. ☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

50-1212/INDA:005USD1 (if check is missing)

The Director of the USPTO is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee to the application identified above. NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature _____

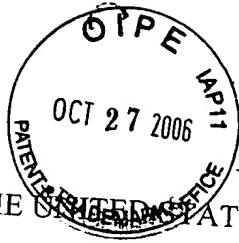
Date October 3, 2005

Typed or printed name Gina N. Shishima

Registration No. 45,104

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Lei Yu

Serial No.: 09/626,616

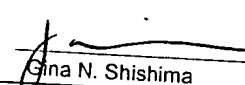
Filed: July 27, 2000

For: POLYNUCLEOTIDE ENCODING MU
OPIOID RECEPTOR

Group Art Unit: 1647

Examiner: R. Landsman

Atty. Dkt. No.: INDA:005USD1

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October 3, 2005	
Date	Gina N. Shishima

RESPONSE TO EXAMINER'S AMENDMENT

MS Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The amendment to the claims by Examiner's amendment is not an acquiescence by Applicant regarding the patentability of any claims prior to amendment. Moreover, Applicant reserves the right to pursue the claims prior to their amendment in any continuing application.

If any fees are required, the Commissioner is authorized to deduct the appropriate fee from Fulbright & Jaworski Account No.: 50-1212/INDA:005USD1.

Respectfully submitted,



Gina N. Shishima
Reg. No. 45,104
Attorney for Applicant

FULBRIGHT & JAWORSKI L.L.P.
600 Congress Avenue, Suite 2400
Austin, Texas 78701
(512) 474-5201

Date: October 3, 2005